

## **REMARKS**

### **A. The Section 112 Rejections**

Claims 19 and 32 were rejected under 35 U.S.C. §112, first paragraph, the Examiner taking the position that the phrase “that are not grouped” is a negative limitation that does not have basis in the original disclosure. The Applicants disagree and traverse these rejections for at least the following reasons.

The Applicants note that “[t]he current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph”, *see* MPEP 2173.05(i).

Further, the fact that the specification does not literally state the negative, namely, that a nearby device is selected from among a plurality nearby devices that are not grouped is not sufficient to establish a *prima facie* case under §112 (*see* MPEP 2173.05(i) and *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993) cited therein). Instead, as long as the original specification reasonably conveys to one skilled in the art that a nearby device is selected from nearby devices that are not grouped, the claims satisfy §112.

Turning to the specification, in paragraph [0020], the specification explains how a user may select a device in accordance with one embodiment of the claimed invention:

“When no more response signals are received as detected at processing segment 32, the microprocessor 13 queries the GPS receiver 17 at segment 34 and determines the location of each electronic device 20 that responded relative to the location of electronic device 10 at segment 35. The microprocessor 13 then illustrates each other electronic device 20 as an icon corresponding to the device type of each other device 20 on the display 14 arranged according to their relative locations and altitudes to electronic device 10 at segment 36. If the area displayed is too

large, the user can set the maximum distance that **an** electronic device 20 can be from the user and still be displayed. At this point, the user can select **an** electronic device 20 to communicate with at processing segment 37, by, for example, keyboard, mouse, touch pad input, touch screen, etc. If the user selects **a** device to communicate with at processing segment 37, the microprocessor 13 begins a communication routine with **the** selected device and returns to processing segment 37 so that the user can select **another** electronic device 20" (emphasis added).

It is clear from the above that the nearby device that is selected by a user is individually selected from nearby devices that have not been grouped either before or during the selection.

Similarly, after each device is located it is individually arranged on a display without first being grouped.

Still further, another indication that the claimed devices are not grouped is the fact that, if an individual device is too far from a user, then it will not be displayed because the user has the option of setting the maximum distance that a device can be from the user and still be displayed. In contrast, if the device were part of a group then the specification would necessarily have to address whether the entire group cannot be displayed if an individual device within the group is too far from a user. The fact that the specification does not address such a scenario is an indication that the nearby devices are not grouped.

In the Final Office Action (see page 3) the Examiner states that "Applicant's specification seems to suggest 'grouping'" and that the "Applicant is attempting to overcome the prior art by using claim terminology from the cited references rather than Applicant's own specification" (see page 4). Applicants disagree.

None of the excerpts from the instant specification cited by the Examiner (or any other specification excerpt) discloses or suggests grouping. The excerpt from paragraph [0015] cited by the Examiner does not mention grouping, nor is grouping suggested. In fact, paragraph [0015] suggests the opposite because

none of the "nearby electronic devices" are formed into groups. As consistently used throughout the present examination, "grouping" or "grouped" has meant, and means, explicitly forming a subset or subgroup of nearby electronic devices before communicating with such devices. The fact that all of the nearby devices are displayed, and not some subset of such devices, means no grouping occurs.

The Examiner also refers to dependent claim 3 which states that only devices "within a certain range" are displayed. Again, because all nearby devices within a certain range are displayed, and not some subset of such devices, this does not suggest grouping. Further, the Applicants note that this phrase is contained within a dependent claim, and not independent claim 19 or 32. Yet further, the Applicants note that the phrase "within a certain range" does not relate to, modify or limit the phrase "'are not grouped" within claim 19. Rather, the words in claim 3 appear to modify the subject matter of dependent claim 30 (GPS co-ordinates). Thus, the interpretation of the subject matter of claim 3 does little to resolve the issue of the meaning of the phrase "are not grouped" within claims 19 and 32.

The Applicants also note that the phrase "are not grouped" is not found in the prior art. In fact, Fumarolo discloses just the opposite. To the extent that the *scope* of the prior art (e.g., grouping into subgroups or subsets prior to communication as in Fumarolo) is used as a consideration in amending the claims, this is unquestionably permissible. Further, the claims can be amended to use words from the entire English vocabulary provided, of course, the specification supports the use of such words (which it does).

To reiterate, the Applicants submit that the specification does not require that nearby devices be grouped. Therefore, Applicants' claims simply express what is clearly made explicit or implicit in the specification. Furthermore, even if somehow the instant specification can be interpreted as disclosing an alternative embodiment that allows for the grouping of nearby devices (i.e., does not exclude grouping), Applicants are permitted to select and claim the

embodiments of the invention which do not require grouping (as is the case presently).

In sum, Applicants submit that one of ordinary skill in the art upon reading the claims and the specification would indeed conclude that the inventors had possession of the claimed invention, namely, methods and devices for selecting a nearby device, from among a plurality of nearby devices that are not grouped to communicate with, at the time the instant application was filed.

Accordingly, Applicants request withdrawal of the rejections and allowance of claims 19 and 32.

**B. The Section 103 Rejections**

**(i) The combination of Fumarolo, Bork and Tognazzini does not suggest the claimed inventions**

Claims 3, 5, 19 and 30-37 were rejected under 35 U.S.C. §103(a) based on the combination of U.S. Patent No. 6,204,844 to Fumarolo et al ("Fumarolo"), U.S. Patent No. 6,246,376 to Bork et al ("Bork") and newly cited U. S. Patent No. 5,907,293 to Tognazzini ("Tognazzini"). Applicants respectfully disagree and traverse these rejections for at least the following reasons.

Initially, Applicants note that the Examiner refers to Tognazzini as U.S. Patent No. 5,906,293 (page 4) and as "Goldberg" (page 5). Both appear to be incorrect. Applicants request clarification of the rejections in the next official action.

Of the rejected claims, claims 19 and 32 are independent claims. It is to these claims that the Applicants now turn, it being understood that the remarks which follow apply to the remaining dependent claims.

Each of the claims of the present invention includes the features of a method or device for: (a) transmitting a Bluetooth signal; (b) detecting a plurality of Bluetooth signals from nearby devices that are not grouped, each signal containing GPS coordinates of at least one nearby device and a device

type of the at least one nearby device; and (c) selecting one of the nearby devices that are not grouped associated with one of the detected signals to communicate with based on the received GPS coordinates.

As the Applicants understand the §103 rejections, the Examiner is relying on the combination of Fumarolo and Tognazzini for feature (b) and Fumarolo for feature (c).

Applicants note that neither Fumarolo nor Tognazzini discloses or suggests features (b) and (c) set forth above.

Turning first to Fumarolo, Fumarolo explicitly discloses the grouping of devices into "talk groups". More particularly, Fumarolo appears to select a group of devices or an individual device that have/has been grouped according to GPS co-ordinates. This is inopposite to the claimed invention.

In the Office Action the Examiner argues that Fumarolo "clearly discloses that a user selects a communication unit prior to grouping the units into a talk group", citing Figure 6 and items 605 and 613 (see page 2 of Final Office Action). This is incorrect.

As the specification of Fumarolo explains, Fig. 6 relates to "un-grouping". That is, after a communication unit is part of one talkgroup, it may be re-grouped into a different talkgroup (see Figure 5 and column 5, line 42 to column 6, line 26). Sometime after the re-grouping, an "ungroup" command may result in the communication unit rejoining its previous talkgroup (see Fig. 6, and column 14, line 27 to column 15, line 6).

Thus, rather than disclose selecting a communication unit prior to grouping its units into a talk group Fumarolo explicitly discloses selecting one communication unit from a talkgroup to communicate with only after the selected unit has been grouped or re-grouped into a talkgroup.

Turning to Tognazzini, the Examiner appears to rely on Tognazzini as disclosing the feature of a "detecting a device type of the nearby device" (see page 6 of the Final Office Action). Applicants disagree.

As set forth in the specification, the phrase "device type" as used in the

claims means a type of *communication* device (see paragraph [0019], lines 3 and 4 of the instant specification). In contrast, the type of device disclosed by Tognazzini appears to be a vehicle.

When properly interpreted the Applicants submit that the subject matter of claims 3, 5, 19, 30-35 and 37 would not have been obvious to one of ordinary skill in the art at the time the instant application was filed based on the combined disclosures of Fumarolo, Bork and Tognazzini.

**(ii) The combination of Fumarolo, Bork and Tognazzini is improper**

The Applicants submit that one of ordinary skill in the art would realize that the particular Bluetooth based system in Bork could not be used in the system of Fumarolo or Tognazzini because such a Bluetooth system would most likely not have the distance or range needed to carry out the principle of operation of Fumarolo or Tognazzini.

Bluetooth systems provide short range communications (see Bork, column 1, lines 44-47) of approximately 100 meters (Bork, column 1, lines 51-52).

In contrast, the principle of operation in Fumarolo requires a signal to travel distances outside the range of a Bluetooth signal, as in the case where communication units belonging to a number of different agencies (i.e. fire department, police department, ambulance) must be grouped together, especially when the individuals operating such units are enroute to an incident (e.g. accident, fire).

In the Board of Patent Appeals & Interferences decision dated August 24, 2009, in supporting the Examiner's position, the Board states that both "Fumarolo and Bork disclose utilizing group communications in a limited geographic area such as several streets or a shopping mall" (Decision at page 7). However, the claims are directed at specific Bluetooth signals not generalized communications, or signals within some undefined geographic distance or within a shopping mall. Further, it is well known that Bluetooth

signals do not propagate over several streets.

Further, the Applicants note that combining Bork and Tognazzini would also appear to require Tognazzini to impermissibly change its principle of operation. In Tognazzini, a collision between two vehicles is avoided by first calculating the projected path of two vehicles and then displaying visual alerts and/or generating audible alerts (see Tognazzini, column 8, line 59 to column 9, line 4). Tognazzini appears to rely upon RF signals to calculate distances that are used to calculate the projected paths. As is known by those skilled in the art, the RF signals of Tognazzini and the claimed Bluetooth signals are not the same. Further, Tognazzini appears to rely upon the fact that vehicles are at some distance from one another so that its alerts can be displayed/generated and then recognized by the driver of one of the vehicles in time to avoid a collision. Given the short distance travelled by Bluetooth signals, it appears that the use of a Bluetooth signal in Tognazzini would require Tognazzini to change its principle of operation when calculating distances (i.e., distances over 100 meters could not be calculated) and eliminate the usefulness of Tognazzini's alerts (i.e., there is no time for a driver to recognize Tognazzini's alerts).

Accordingly, the Applicants maintain that the combination of Fumarolo, Bork and Tognazzini is improper for at least the reasons set forth above. The Applicants respectfully request withdrawal of the pending rejections and allowance of claims 3, 5, 19, 30-35 and 37.

**C. Entry of Amendment After Final**

Entry of this Amendment After Final ("AAF") is solicited because the AAF: (a) places the application in condition for allowance for the reasons discussed herein; (b) does not raise any new issues requiring further search and/or consideration; (c) does not present any additional claims without canceling the corresponding number of finally rejected claims; and (d) places the application in better form for appeal, if an appeal is necessary.

Should there be any outstanding matters that need to be resolved in the present application the Examiner is respectfully requested to contact John E. Curtin at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3777 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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